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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL B. GRAHAM JOHN A. WOFFINGTON, IV, and
STEVEN P. WOLF

Appeal 2009-010005
Application 09/945,378
Technology Center 3600

Before: MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 33-49 and 64-70. We have jurisdiction to review the case under 35 U.S.C. §§ 134 and 6 (2002).

The claimed invention is directed to systems and methods for providing advertising to a consumer utilizing electronic media; and more particularly, to a computerized system and method for providing advertising to a consumer and/or for gathering statistical data from the consumer associated with a commercial entity's products and/or services (Spec. 1:6-9).

Claim 33, reproduced below, is further illustrative of the claimed subject matter.

33. A computerized method for measuring a consumer's perception of a commercial entity's brand equity, logo, trademark, tradename, tag line, product name and the like, comprising the steps of:

 providing a present interactive advertising message to the consumer;

 allowing the consumer to interact with the present interactive advertising message;

 gathering data associated with the consumer's interactions with the present interactive advertising message;

 generating a statistical report from the data; and

 providing the statistical report to the commercial entity.

Claims 33-49 and 64-70 stand rejected under 35 U.S.C. § 101 for failing to recite patentable subject matter; claims 33-37, 42, 44-49 and 64-70 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Guyett (US Pat. 6,764,395 B1, iss. Jul. 20 2004) in view of McIntyre (US Pub.

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2003/0191690 A1, pub. Oct. 9, 2003); and claims 38-41 and 43 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Guyett in view of McIntyre and Forrest (US Pat. 5,679,075, iss. Oct. 21, 1997).

We AFFIRM.

ISSUE

Did the Examiner err in asserting that claims 33-49 and 64-70 are not directed to statutory subject matter as set forth in 35 U.S.C. § 101?

ANALYSIS

We are not persuaded that the Examiner erred in asserting that claims 33-49 and 64-70 are not directed to statutory subject matter as set forth in 35 U.S.C. § 101 (Reply Br. 4-5). At an initial glance, the claims appear to merely state the general concept of interacting with, gathering, and outputting advertising message data.

To determine whether the claimed process subject matter is patent-eligible under 35 U.S.C. § 101, various factors must be considered and weighed when analyzing claims as a whole before reaching a conclusion on patent subject matter eligibility.

The factors relevant in this analysis are the presence or absence of recitations in the claims to a machine or transformation and whether the claims are mere statements of a general concept.

Regarding machines, Appellants assert that all the claims are tied to computers and other computerized machines (Reply Br. 4-5). Independent claim 33, however, is a method that merely recites a computer in the preamble. Such a recitation is merely a field-of-use limitation. While

independent claim 33 does recite “generating a statistical report from the data,” such a step constitutes insignificant postsolution activity. “*Flook* stands for the proposition that the prohibition against patenting abstract ideas ‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’” *Bilski v. Kappos*, 130 S. Ct. 3218, 3230 (2010) (*citing Diamond v. Diehr*, 450 U.S. 175, 191-92 (1981)). Thus, limiting the implementation of what would otherwise be mental steps or abstract ideas to a “computer” environment and “generating” activity is insufficient to place the subject matter of independent claim 1 into the realm of patentable subject matter under 35 U.S.C. § 101.

There is no recitation of a transformation, even of data. There is only creation of data.

And, as broadly construed, independent claim 33 merely states the general concept of interacting with, gathering, and outputting advertising message data. The claims cover any use of the concept of interacting with, gathering, and outputting advertising message data, known and unknown. The instructions could be performed by any machine, existing or future-devised. Furthermore, the processes as claimed could be accomplished by human activity alone, including through mental processes. In the words of *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972), the claimed processes “would wholly pre-empt the [interacting with, gathering, and outputting advertising message data] and in practical effect would be a patent on the [concept] itself.”

The same analysis applied to independent claim 33 is also applicable to independent claim 67. While independent claim 67 does recite a

“computerized game” in the body of the claim, we believe such a *de minimis* recitation of structure is still insufficient to make the computer more than a field-of-use limitation.

For the foregoing reasons, based upon consideration of all of the relevant factors, claims 33-49 and 64-70 are held to claim an abstract idea, and thus we sustain the rejection of these claims for reciting ineligible subject matter under 35 U.S.C. § 101.

We do not reach the merits of the prior art rejections of claims 33-49 and 64-70 because they do not recite patent eligible subject matter under 35 U.S.C. § 101. *See Diamond*, 450 U.S. at 188; *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (declining to reach an obviousness rejection on appeal after concluding many claims were nonstatutory under § 101); *In re Rice*, 132 F.2d 140, 141 (CCPA 1942) (finding it unnecessary to reach a rejection based on prior art after concluding claims were directed to nonstatutory subject matter); *Ex Parte Gutta*, 93 USPQ2d 1025, 1036 (BPAI 2009) (per curiam) (expanded panel) (precedential) (as the claims on appeal do not recite patent-eligible subject matter under § 101, the prior art rejections need not be considered).

DECISION

The rejection of claims 33-49 and 64-70 under 35 U.S.C. § 101 is
AFFIRMED.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

hh

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